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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,644	09/29/2005	Shusei Takano	1131-0544PUS1	5443
2292 7590 03/26/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER FELTON, MICHAEL J				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
03/26/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/551,644

Applicant(s)

TAKANO ET AL.

Examiner

MICHAEL J. FELTON

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 3/12/2007, 9/29/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ray (US 4,284,089). Ray discloses a nicotine inhalation pipe that contains a liquid absorbent that contains nicotine, so that the nicotine can be released when air is drawn through the device. As can be seen in figure 1, Ray provides a mouthpiece (element 16) and that the inhalation path (28) is distinctly separated from the liquid absorbent (14).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (US 4,284,089) as applied to claim 1 above in further view of Clearman et al. (US 4,756,318). Ray clearly discloses liquid absorbent between the outer tube and an inner inhalation path tube, but does not disclose a plurality of holes in an inner tube. However, Clearman et al. disclose an absorbent structure with a tube that contains a plurality of passages (i.e. holes, as seen if figure 1, element 17) that permit the passage of air and gasses (col. 7, 11-18). It would have been obvious to one of ordinary skill in the art at the time of invention to use such a tube as disclosed by Clearman et al. to separate the liquid absorbent from the inhalation path, as the liquid absorbent could be in beads as disclosed by Clearman et al.

7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (US 4,284,089) as applied to claim 1 above in further view of Banerjee et al. (US 4,938,236). Ray does not disclose a structure with the nicotine containing substance with a plurality of passages in the axial direction, or with a plurality of passages on the outer peripheral surface of the absorbent and inside the outer tube. However, Banerjee et al. disclose an aerosol inhaler with a star shaped nicotine source (figure 2, element 11) with inhalation paths on the outer peripheral surface and defined by the inner surface of the outer tube. Banerjee et al. teach the use of an extruded tobacco, however it would have been obvious that other sources of nicotine could also be used for the delivery of aerosol, for instance the nicotine absorbent of Ray. Therefore, it would have been obvious to use the air paths of Banerjee et al. in the invention of Ray, as the surface area of absorbent exposed to inhalation air would be increased.

8. Claims 5-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ray (US 4,284,089) as applied to claims 1 and 8 above in further view of Rindner (US 3,320,953).

9. Regarding claims 5, 6, 9, and 10, Ray does not disclose using silica beads in a central tube with end walls with opening smaller than the beads. However, Rindner discloses a cigarette alternative that contains silica gel bead absorbents that contain flavors in a central tube held in place by perforated stoppers in the center of a tube designed to look like a cigarette. It would have been obvious to one of ordinary skill in

the art at the time of invention to use nicotine as taught by Ray in the form of beads as taught by Rindner, since both are in the art of cigarette alternatives.

10. Regarding claims 7 and 11, Ray discloses that the tube may be made from a variety of materials including aluminum, glass, and Teflon. However, Ray discloses that the materials and appearance are design choice in order to increase adoption of the product. Ray states:

Suitable materials for container 12, for example, include aluminum, glass, and teflon. In a preferred embodiment of the invention, the container 12 is manufactured with a diameter, length, and weight which approximate the size of a conventional cigarette. Furthermore, the container may be provided with the appropriate color to present the same appearance as a cigarette. In addition, a band 20, made of paper, cork, or another suitable material, may be applied around the mouth end 16 of the device to simulate the appearance of the filter tip on a conventional cigarette. By thus making the device similar in appearance to a conventional cigarette, the appeal of this device as a substitute for a combustible cigarette will be enhanced, since the user may thus psychologically tend to feel as if he or she is handling and using a familiar smoking product.

It would have been obvious to one of ordinary skill in the art at the time of invention use a variety of materials, including resins such as Teflon, to fashion an inhaler that would be marketable. Ray's disclosure of glass, a transparent material, indicates that Ray anticipated a transparent outer tube, and Ray discloses that the appearance of the tube is important for marketability.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is

(571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. F./
Examiner, Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791